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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/731,284	12/09/2003	Markus Nesper	HOE-790	4912
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Lipsitz & McAllister, LLC
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EXAMINER

SHAFFER, RICHARD R

ART UNIT	PAPER NUMBER
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3733

MAIL DATE	DELIVERY MODE
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10/04/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/731,284	NESPER ET AL.	
	Examiner	Art Unit	
	Richard R. Shaffer	3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 July 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) 25,26 and 29-33 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-19,22-24,27 and 28 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 July 2007 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

The amended drawings filed on July 9th, 2007 are acknowledged and accepted by the examiner. The previous drawing objections are hereby withdrawn.

Claim Objections

The amendments to the claims filed on July 9th, 2007 are acknowledged and accepted by the examiner. The previous claim objections are hereby withdrawn.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-24, 27 and 28 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-25 of U.S. Patent No.

7,238,188 (corresponds to the previously provisionally rejected application 10/718,851).

Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the difference between this application and the copending applications lies in the fact that the copending applications have claims that include more elements and are thus more specific. Thus, the copending applications are in effect a "species" of the "generic" invention as claimed in this application. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

Claims 1-24, 27 and 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-26 of copending Application No. 10/911,982 and claims 1-35 of copending Application No. 11/702,258. Although the conflicting claims are not identical, they are not patentably distinct from each other because the difference between this application and the copending applications lies in the fact that the copending applications have claims that include more elements and are thus more specific. Thus, the copending applications are in effect a "species" of the "generic" invention as claimed in this application. It has been held that the generic invention is anticipated by the species. See *In re Goodman*, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-11, 13-24, 27 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Lerch et al (DE 199 52 359 C1).

Lerch et al disclose an implant (**Figures 1-3**) comprising: an inner abutment element (**18/38/64**); an outer abutment plate (**20/52/66**); a bendable/flexible tension band (**28**) fixable on the outer abutment element as well as fastened to the inner abutment element; the band passes through a first rounded opening (**24a**) located in the inner abutment member, bends around to pass through a second rounded opening (**24b**) also located in the inner abutment member spaced from the first opening causing two portions of the tension band to be parallel to one another (**especially Figures 1 and 2**); the outer abutment member has one or more openings (**32a and 32b/60a and 60b/70**) for allowing the tension band to pass through; the outer abutment openings have rounded deflection edges; the tension band is hookable relative to the outer abutment member along with the outer abutment member including hook elements (**54/72**) with an inclined/steep flank; a dimension of the tension band is greater than another (thereby covering the width is greater than the height); and a dimension of the tension band is in the region between 25% and 75% of a dimension of an abutment element (any type of measurement from an abutment element can suffice, such as openings, spacing between specific features, or any arbitrary locations due to the non-limiting language). In regard to the limitation of the tension band being fixable by penetration of the hook elements (**54,72**), the clamping action of the wedge in order to firmly hold the thread (tension band **28**) would at least cause a surface roughness of the

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wedge to partially penetrate the thread to prevent sliding. Further, the band is fixable should one also decide to form notches in the thread (or wire embodiment) to which the clamp would engage.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lerch et al evidenced by Akerfeldt et al (US Patent 6,508,828) and Bonutti (US Patent 6,045,551).

Lerch et al disclose all of the claimed limitations except for the spacing of the openings of the inner abutment plate being less than an eighth of a width dimension of the inner abutment element. It would have been obvious to one of ordinary skill in the art at the time of invention to modify the distance between the holes in the bottom plate as a matter of substitution of providing openings to receive a flexible member with predictable results. This is supported by related prior art (**Bonutti - Figure 2** and **Akerfeldt - Figure 1**) having structure of an inner plate member having holes roughly 1/8 the width of the plate.

Response to Arguments

Applicant's arguments filed on July 9th, 2007 have been fully considered but they are not persuasive. Applicant alleges that Lerch et al fail to disclose hook elements

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penetrating at least one tension band. The flexible wire/thread of Lerch et al since it's flexible and tensed can be interpreted as a tension band given the broadest reasonable interpretation. In regard to the limitations "the at least one tension band fixable relative to the outer abutment element by penetration of the one or more hook elements into the at least one tension band" is deemed anticipated by Lerch et al. As explained in the current Office Action, inherent surface roughness of the components would penetrate one another in order to frictionally lock the thread/wire relative to the plate. Further, the limitation states that the band needs to merely be able to be "penetrated" by the hook elements. Therefore, as also stated, if a notch were formed in the thread/wire, then that notch could be "penetrated" by the edge of the hook elements and therefore fix the thread/wire relative to the plate (in combination with the clamp action).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard R. Shaffer whose telephone number is 571-272-8683. The examiner can normally be reached on Monday-Friday (7am-5pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Richard Shaffer
September 29th, 2007



EDUARDO C. ROBERT
SUPERVISORY PATENT EXAMINER